

O/0456/25

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3529661
IN THE NAME OF COMPASS COMMS LIMITED FOR THE MARK**

Social Work News

IN CLASSES 16, 35, 38 AND 41

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 506186 BY SANCTUARY PERSONNEL LIMITED**

Background and pleadings

1. On 3 September 2020, Compass Comms Limited (“the registered proprietor”) applied for the trade mark Social Work News (application 3529661), for the following goods and services in classes 16, 35, 38 and 41:

Class 16: Books; Printed books; Printed educational materials; Printed matter; Printed news releases; Printed newsletters; Printed periodicals; Printed promotional material; Printed publications.

Class 35: Advertising analysis; Advertising and advertisement services; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotion services and related consulting; Advertising and promotional services; Advertising and publicity; Advertising and publicity services; Advertising in periodicals, brochures and newspapers; Advertising material (Dissemination of -); Advertising research; Advertising research services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising; Advertising services relating to the recruitment of personnel; Advertising services relating to the sale of goods; Advertising services to promote public awareness of social issues; Advertising space (Rental of -) on the internet; Advertising via electronic media and specifically the internet; Advertising via the Internet ;Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Compilation of advertisements; Compilation of advertisements for use as web pages; Compilation of advertisements for use as web pages on the Internet; Compilation of advertisements for use on the internet; Conducting of trade shows; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Development of promotional campaigns; Dissemination of advertisements;

Event marketing; Exhibitions (Arranging -) for advertising purposes; Exhibitions (Conducting -) for advertising purposes; Job matching services; Magazine advertising; Marketing, advertising, and promotional services; Marketing services provided by means of digital networks; Online advertisements; Online advertising; On-line advertising and marketing services; Pay per click advertising; Preparation and presentation of audio visual displays for advertising purposes; Preparing audiovisual presentations for use in advertising; Product launch services; Product marketing; Providing advertising services; Providing advertising space; Providing advertising space in periodicals, newspapers and magazines; Providing and rental of advertising space on the internet; Providing recruitment information via a global computer network; Provision and rental of advertising space; Provision of advertising space; Provision of space on websites for advertising goods and services; Recruitment advertising; Recruitment of personnel; Retail services in relation to downloadable electronic publications; Texts (Publication of publicity -).

Class 38: Audio and video broadcasting services provided via the Internet; Chat room services for social networking; Collection and delivery of messages by electronic mail; Communication services for video conferencing purposes; Electronic file transfer; Electronic forwarding of messages; Electronic mail and messaging services; Electronic transmission of news; Interactive transmission of video over digital networks; Providing access to an Internet discussion website; Providing on-line chat rooms for social networking; Transmission of audio and video content via computer networks; Transmission of information on-line; Transmission of news; Transmission of podcasts; Transmission of webcasts; Transmission of written communications (Electronic -).

Class 41: Providing electronic publications; Providing on-line publications; Publication of books, magazines, almanacs and journals; Publication of documents in the field of training, science, public law and social affairs; Publication of educational and training guides; Publication of educational materials; Publication of electronic books and journals online; Publication of electronic magazines; Publication of journals; Publication of magazines; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publishing of web magazines.

2. The trade mark was registered on 25 December 2020. On 9 June 2023, an application for a declaration of invalidity was filed by Sanctuary Personnel Limited (“the applicant”) under sections 47(1)/3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 (“the Act”).

3. The specific claims made are:

- Section 3(1)(a): “The mark “Social Work News” lacks the capacity of distinguishing goods or services of one undertaking from those of other undertakings. It therefore lacks the necessary characteristics to serve the function of a trade mark registration as it lacks the capacity to immediately, and without further education, identify trade origin. Registration should be invalidated on absolute grounds as it offends against s47(1), s3(1)(a) and s1(1) UK TMA 1994 respectively.”
- Section 3(1)(b): “The mark “Social Work News” consists solely of the readily understood words with no additional elements to lend or create [sic] a minimal level of distinctive character, thereby allowing the mark to discern the holder’s goods/services as theirs alone. It therefore lacks the capacity to distinguish or identify trade origin. Registration should be invalidated on absolute grounds as it offends against s47(1) & s3(1)(b) UK TMA 1994 respectively.”
- Section 3(1)(c): “The mark “Social Work News” is a mark that consists exclusively of a sign which may serve in trade to designate the kind of goods and services being provided, such as, publications, advertising, promotions, events, electronic publications and digital communications. The average consumer would not see this as a distinctive badge of origin but would rather see it as an indication that the goods and services provided relate wholly on the topic of social work. Registration should be invalidated on absolute grounds as it offends against s47(1) & s3(1).”

4. The registered proprietor filed a defence and counterstatement, denying the grounds. It also claimed that the invalidation should be struck out as an abuse of process, because it had been brought thirteen working days after the applicant had been unsuccessful in a previously filed invalidation action against the same registration.¹ A hearing was held to determine the merits of the abuse of process claim. The registrar found that it was not an abuse of process to bring this, second, invalidation action. The registered proprietor appealed that interim decision, with the leave of the registrar. The decision was upheld by Mr Thomas Mitcheson KC, sitting as the Appointed Person, in BL O/0050/24.

5. The applicant is represented by Birketts LLP and the registered proprietor is represented by Swindell & Pearson Ltd. Both parties filed evidence. Neither party asked to be heard and both filed written submissions in lieu of a hearing. I held a case management conference (“CMC”) on 15 November 2024 regarding the registered proprietor’s written submissions in lieu of a hearing, which the Tribunal deemed partially inadmissible as they included four ‘witness statements’, after the closure of the evidence rounds. There was no request to file further evidence; instead the registered proprietor replied to say that it had filed ‘pleadings’, which prompted the appointment of the CMC upon the Tribunal’s continued refusal to admit the witness statements. The characterisation of the documents as ‘pleadings’ caused some confusion, which was resolved at the CMC: the registered proprietor’s trade mark attorney explained that what was meant was that the ‘witness statements’ should form submissions, but not evidence. The registered proprietor had prepared the documents and requested that its attorney file them, along with conventional written submissions which were prepared by the attorney (which are admissible). At the CMC, I said that I would review all the ‘witness statements’ to see if they contained content which could be regarded as arguments rather than facts. Having done so, I considered that they all consisted entirely of facts, including new facts which the applicant had not previously seen. My decision was that they were inadmissible and would not play any part in the proceedings (subject to what I say about them later in this decision).

¹ Decision BL O/0473/23, in which the grounds were sections 3(6) and 5(4)(a) of the Act.

6. I make this decision after a careful reading of all the papers and will refer to them where relevant and necessary.

Sections 47(1)/3(1)(a), (b) and (c) of the Act

7. Section 47(1) of the Act states:

“The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

8. Sections 3(1) (a), (b) and (c) state:

“**3.—** (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

[...]:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

9. Section 1(1) of the Act states:

“(1)1 In this Act “trade mark” means any sign which is capable—

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”

10. The relevant date for determining the above grounds of invalidation is the date on which the contested mark was filed, 30 September 2020; except in relation to the proviso in section 47(1), the effect of which is that the registration shall be saved if it

is shown that the mark had acquired distinctive character by the date of the application for invalidation; i.e. by 9 June 2023.²

Section 3(1)(a)

11. In its written submissions in lieu of a hearing, the applicant submits:³

“21. The Contested mark, without further education, lacks the capacity to identify trade origin and therefore lacks the necessary characteristics necessary to serve the function of a trade mark registration as it fails to meet the requirement of s(1)(1) TMA 1994 due to its incapacity to distinguish.

22. The Proprietor admitted this position by default as they did not dispute this finding by providing any evidence to the contrary within the evidence rounds.”

12. Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *AD2000 Trade Mark*, said that section 3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “not being incapable” of distinguishing.⁴ Consequently, if I am satisfied that the mark complies with sections 3(1)(b) or (c) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if either of the grounds under section 3(1)(b) or (c) succeed, the outcome under section 3(1)(a) becomes moot. In any event, this ground of opposition fails for the reasons given by Arnold J (as he then was) in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch):

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a

² See, to that effect, paragraph 179 of *The London Taxi Corporation v Frazier-Nash Research Limited and anor* [2016] EWHC 52 (Ch); and paragraph 29 of *Harley Doctor Limited v Samedaydoctor (London) Limited*, Case BL O/577/15

³ Filed 16 September 2024

⁴ [1997] RPC 168.

sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those

particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

13. The mark is not incapable of distinguishing any goods or services. **The section 3(1)(a) ground fails.**

Evidence

14. The applicant's evidence-in-chief comes from Melanie Harvey, the applicant's trade mark attorney. Ms Harvey's first witness statement is dated 8 April 2024.⁵ There is no factual content beyond a statement that it is not believed that the registered proprietor used its mark prior to the relevant date and before it was registered. Other than this, the witness statement consists entirely of a statement of the applicable sections of the Act and submissions. For example:

"17. Equally, the application should have been found to offend under Section 3(1)(c) of the Act with the related objection being raised in the Examination phase of the underlying application as the mark consists exclusively of a sign which may serve in trade to designate the kind of the goods and services e.g. publications and news services centred on providing news in the field of social work, or, "Social Work News".

18. When met with the sign "Social Work News" for goods such as printed materials and publications and services such as the provision of news, be that via advertising, communication or publications, the average consumer would not see this as a distinctive badge of origin but would rather see it as an

⁵ Ms Harvey's second witness statement, dated 12 August 2024, was filed as evidence-in-reply.

indication that the goods and services provided news on the topic of social work, or what is happening in the social work field.

19. For marks to be considered a trade mark, they must be capable of distinguishing their goods and services from those of similar undertakings, which has not been provided at this time and on that basis the registration is believed to offend against Section 3(1)(c) of the Act as the mark is wholly descriptive in context of the goods and services as registered.”

15. The registered proprietor’s evidence comes from Kieron Taylor, its trade mark attorney.⁶ The majority of the witness statement serves as a means to adduce witness statements from the following individuals and documents pertaining to the applicant’s own application for the mark SOCIAL WORK NEWS (number 3830328):

- Exhibit KPMT01: the witness statement of Mark Pearson dated 28 February 2023, also containing Appendix 1 which comprises a statement of Ruth Stark dated 23 February 2023 (it is not a witness statement);
- Exhibit KPMT02: the witness statement of Kellie Doubtfire dated 26 September 2022, plus exhibits KD1 to KD6 to her statement;
- Exhibit KPMT04: the applicant’s arguments filed in support of its application to register SOCIAL WORK NEWS.

16. Exhibit KPMT03 is a copy of the previously mentioned decision against the contested mark (in which the applicant for invalidation failed under sections 3(6) and 5(4)(a)). Mr Taylor states that, following this decision, the applicant filed its own application for SOCIAL WORK NEWS, maintaining that it was registrable. Shortly after it was published for opposition purposes, the applicant withdrew its application. Mr Taylor concludes by submitting that the contested mark is registrable “which both parties have pleaded.” This appears to be a reference to the fact that the applicant had, at the *ex officio* examination stage, maintained that the Intellectual Property Office should accept its trade mark application.

⁶ Witness statement dated 10 June 2024 and exhibits.

17. None of the individual witness statements adduced by Mr Taylor as evidence-in-chief were prepared for these proceedings: they all pre-date the launch of the present invalidity action. Mr Pearson's statement was filed in relation to the previous invalidity action (as written submissions). This makes it somewhat hard to follow because it critiques evidence and submissions from the applicant filed in the previous invalidity action, not in these proceedings, and refers in several places to evidence from a Mr James Rook. Mr Rook was a witness for the applicant in the previous invalidity proceedings and in relation to the evidence which the applicant filed in support of its own trade mark application (according to exhibits KPMT03 and KPMT04). That evidence has not been filed in the present proceedings and so references to Mr Rook are not relevant. There is substantial content which relates to the activities of the applicant. This is not relevant: there are no relative grounds running in the present proceedings; no bad faith ground; and the grounds all relate to whether the registered proprietor's registration is valid on absolute grounds under sections 3(1)(a), (b) and (c) of the Act, not what the applicant has or has not done. The activities of the registered proprietor may be relevant to the question as to whether its own mark has acquired distinctiveness through its own use of SOCIAL WORK NEWS, but the activities of the applicant *per se* are not relevant to that question.

18. I will highlight the main points from Mr Pearson's statement insofar as they are relevant to the present proceedings. Mr Pearson is a director of the registered proprietor. He states that "Social Work" is a generic term which he does not believe could be used as a trade mark. At paragraph 7 of his statement, Mr Pearson states that the registered proprietor investigated the title of Social Work News in 2020 and found no information about it as a specific publication or trade mark, and so registered as such. At paragraph 10 of his statement, Mr Pearson states that many organisations within the sector have been producing materials that include the title social work news (including the International Federation of Social Workers).

19. Appendix 1 to Mr Pearson's statement comprises the statement of Ruth Stark dated 23 February 2023. It is not in the form of a witness statement and does not contain a statement of truth. This means that her statement has only the status of hearsay evidence. Ms Stark was Emeritus Global President of the International

Federation of Social Workers from 2014 to 2018. Ms Stark says that Kellie Doubtfire bought the domain name in 2006 and that Ms Doubtfire and Mr Pearson have developed the publication Social Work News since 2015, launching a website in 2020.

20. Kellie Doubtfire's witness statement was also filed in relation to the previous invalidity action. Ms Doubtfire is the registered proprietor's Publishing and Events Director. She states that the registered proprietor launched and began developing SOCIAL WORK TODAY and SOCIAL WORK NEWS in October 2020, being aware that a trade mark must be 'developed' within five years of being registered. I note from the timeline given in Exhibit KD1 that the launch was in fact in respect of SOCIAL WORK TODAY:

- **19th October 2020:** Social Work Today launched – a social work news online publication with a social work news section. The plan was to eventually develop the news section under its own brand, Social Work News.

21. Ms Doubtfire states that the registered proprietor has been using the contested mark continuously within the Social Work Today brand:

- "It is an integral part of the brand with its own section on the Social Work Today website
- Social Work Today emails are in the form of a newsletter and news is sent to the circulation list at 10am every day. Therefore, Social Work News identifies the service we provide
- There is a specific section called Social Work News on the e-newsletters sent out every morning at 10am
- The domain names www.socialworknews.com and www.socialworknews.co.uk link through to the Social Work Today website."

22. There is no information about how many newsletters are sent out and to whom (although, presumably, to social workers). There are no newsletters in evidence.

There are no screenshots to show the Social Work News section on the Social Work Today website, and no use of the internet archive, the Wayback Machine, to show what that looked like as at, or prior to, the relevant dates. Exhibit KD3 states that the registered proprietor uses the contested mark to complement the full service provided by Social Work Today which is:

- “Social Work News
- Social Work Jobs
- Social Work Events”.

23. Undated examples of promotional material are given, such as the back of a business card:



24. Referring to the applicant’s magazines, Ms Doubtfire states that the title “Social Work” is generic.

25. The remainder of the registered proprietor’s evidence comprises Exhibit KPMT04, which comprises the applicant’s arguments filed in support of its application to register SOCIAL WORK NEWS, and Exhibit KPMT03, which is a copy of the previously mentioned invalidation decision against the contested mark. As mentioned earlier, the applicant for invalidation failed under sections 3(6) and 5(4)(a)) in the previous proceedings. The decision is not relevant to the present proceedings. The grounds are different and I am not bound by any of the findings.

Exhibit KPMT04 is also not relevant. The applicant, when it argued in favour of its own application for the trade mark against the examiner's section 3(1)(b) and (c) objections, had i) seen that the Intellectual Property Office had not raised the same objections against the registered proprietor's mark; and ii) not had the invalidity decision which went against it (which included comments about the lack of distinctiveness of the sign in connection with its passing off claim.) The registered proprietor cannot hold the applicant's previous position with regard to registrability against it. In any event, anyone can apply to have a mark invalidated under absolute grounds and the matter must be considered afresh. I must approach the matter with a clean slate and take into account the evidence and submissions of both parties.⁷

26. The applicant's evidence-in-reply also comes from Ms Harvey, in a second witness statement, dated 12 August 2024. It contains no facts, apart from a statement about why the applicant's own trade mark application was accepted and withdrawn (which is irrelevant). It is a critique of the registered proprietor's evidence and therefore comprises submissions. I will treat the witness statement as submissions.

Section 3(1)(c)

27. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, the Court of Justice of the European Union ("CJEU") described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods."⁸

⁷ See *Swiss Research Labs Limited v Bauer Holdings Limited*, case BL O/1020/22, Mr Iain Purvis KC, sitting as the Appointed Person, at paragraphs 10 to 12.

⁸ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

28. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more

characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it

may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a

property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

29. In *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC observed:⁹

"38. Under section 3(1)(c), the case law both from the EU courts and from the Court of Appeal has emphasized that section 3(1)(c) (or its equivalents) only come into play where the average consumer would, at the relevant date, have immediately perceived without thought or explanation that the mark in question designated a characteristic of the goods or services for which the mark was registered (see *JW Spear & Sons v. Zynga Inc.* [2015] EWCA Civ 290 at [73]- [83] and cases there referred to). The cases also show that it is not necessary to demonstrate that the term exactly designates any of the goods or services specifically itself: designation of a characteristic of such services will suffice, including, importantly, ancillary characteristics that the goods or services may reasonably be expected to have (see e.g. Case C-363/99 *Koninklijke KPN Nederland NV v. Benelux Merkenbureau* [2004] ECR I-1619).

⁹ Case BL O/522/20.

39. Second, the case law under both sub-sections [sections 3(1)(b) and (c)] and the language of 3(1)(c) itself places some emphasis on avoiding registration not only of marks or signs which are already in use by others to describe the goods or services in issue but also those which may reasonably be adopted by others in future to describe their goods or services having regard to the meaning of those terms.”

30. In *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau*, the CJEU stated that if the same ground of refusal is appropriate for a category or group of goods or services, the same reasoning may be applied to all of the goods or services.¹⁰

Class 16: *Books; Printed books; Printed educational materials; Printed matter; Printed news releases; Printed newsletters; Printed periodicals; Printed promotional material; Printed publications.*

31. Exhibit KPMT04 comprises the applicant’s arguments at *ex officio* examination stage in support of its own application. One of the submissions which the applicant made to try to overcome the section 3(1)(b) and (c) objections which the examiner had raised was that other somewhat descriptive magazine titles, over time with use, had come to fulfil the essential function of a trade mark. I note that the Intellectual Property Office’s Trade Mark Manual (Examination) says the following:

“Magazines and magazines titles

By their very nature, magazine titles tend to contain descriptive elements. This is to enable the average consumer to know, more or less, the content of the magazine. Nevertheless, consumers are used to relying on them as indicators of commercial origin and so consequently they can function as trade marks.

This approach was confirmed in *The Adult Channel* (R772/2000-4)) to accept the mark in respect of entertainment services and publications. Whilst not

¹⁰ [2007] ECR I-1455, Case C-239/05

binding upon the Registrar, the reasoning set out in this decision is logical, and reflects the IPO's own practice The decision stated:

“24 Furthermore in the specific field of printed matter, and particularly in that of newspapers, the tolerance of ‘descriptive’ marks has been traditionally broader than in other sectors. This established trade practice should be taken into consideration when assessing the descriptiveness of the mark in relation to the nature of the specified goods, whose relevant consumers, in the case the relevant readers, are so familiar with this practice that they see marks, which they would not acknowledge as such in other areas of trade, as normal.

Whilst consumers may be familiar with such trade practices, this does not mean that wholly descriptive terms intended for use in respect of magazines and closely related goods and services are always automatically acceptable. The most descriptive of terms will still be objectionable even where used on magazines. For example, the mark ‘SEA FISHING MAGAZINE’, applied for in respect of magazines would attract an objection under sections 3(1)(b) and (c).

The mark would also be objectionable for the following goods and services as they are considered closely related to magazines:

Class 9: Electronic magazines (downloadable). Class 16: Printed matter; books; printed publications. Class 41: Publishing services; Non downloadable electronic magazines.

The signs ‘NURSES MAGAZINE’ and ‘NURSING MAGAZINE’ would be objectionable. This is because they are purely descriptive marks which consist essentially of the name of the subject matter (as plainly as it can be) plus the name of the publication type. The signs ‘NURSING TIMES’ and ‘NURSING WEEKLY’ would be acceptable, however, as they are not immediately and exclusively descriptive.”

32. This is, of course, ‘practice’ and I am not bound by it. In any event, the practice would not apply to the contested mark because SOCIAL WORK NEWS does not have any other words such as ‘Weekly’ or ‘Times’. ‘News’ is a noun which describes information about current affairs. Social work is, according to the registered proprietor’s witnesses Mr Pearson and Ms Doubtfire, a generic term. I agree: *Collins Online Dictionary* defines it as “any of various social services designed to alleviate the conditions of poor and elderly people and to increase the welfare of children.”¹¹ Putting ‘news’ together with the words social work, the mark SOCIAL WORK NEWS, describes the kind of goods for which the mark is registered in class 16; i.e. news about social work. SOCIAL WORK NEWS is a natural way of describing news about social work, and for the goods in class 16, the news comes in printed form. The mark tells you what the content of the printed matter is about. Mr Pearson states that many organisations within the sector have been producing materials that include the title social work news (including the International Federation of Social Workers). This is unsurprising given the descriptive nature of the words, fortifying my view that the mark is descriptive. The section 3(1)(c) ground succeeds, *prima facie*, in relation to all of the class 16 goods.

Class 41: *Providing electronic publications; Providing on-line publications; Publication of books, magazines, almanacs and journals; Publication of documents in the field of training, science, public law and social affairs; Publication of educational and training guides; Publication of educational materials; Publication of electronic books and journals online; Publication of electronic magazines; Publication of journals; Publication of magazines; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publishing of web magazines.*

33. The following services are *prima facie* objectionable under section 3(1)(c) of the Act because they consist of the provision of electronic publications about social work news; i.e. social work current affairs: *Providing electronic publications; Providing on-line publications.* The remaining services in class 41 are all publication services. The mark is descriptive of publishing services relating to social work news

¹¹ Dictionary accessed on 21 May 2025.

(publications); i.e. services which publish news about social work. It is therefore *prima facie* objectionable for *Publication of books, magazines, almanacs and journals; Publication of electronic books and journals online; Publication of electronic magazines; Publication of journals; Publication of magazines; Publication of printed matter and printed publications; Publication of printed matter in electronic form; Publishing of web magazines.*

34. The mark is also objectionable for *Publication of documents in the field of training, science, public law and social affairs; Publication of educational and training guides; Publication of educational materials* because these services may relate to social work news. Education and training for professionals operating in the social work sector will entail keeping up to date with what is going on in that line of work: continuing professional development. This means keeping abreast of the latest in social work news developments. Sociology is the science, or academic study, of society and social issues. This has a clear relationship to the academic and educational side of social work. For instance, Ruth Stark says that she has an MSc in Advanced Social Work from Stirling University. Public law is related to social work and the rights of individuals within society, and social affairs is clearly a part of social work (and vice versa). The section 3(1)(c) ground succeeds, *prima facie*, in relation to all of the class 41 services.

Class 38: Audio and video broadcasting services provided via the Internet; Electronic transmission of news; Interactive transmission of video over digital networks; Transmission of audio and video content via computer networks; Transmission of information on-line; Transmission of news; Transmission of podcasts; Transmission of webcasts; Transmission of written communications (Electronic -).

35. These are all services for broadcasting and communicating social work news. The mark therefore describes the kind of services: broadcasting and communication services which deliver social work news. For these services, the mark is *prima facie* objectionable under section 3(1)(c) of the Act. If consumers were, for example, signed up to a service which gave regular social work news notifications, they would expect to receive those notifications in the form of messages, emails or other electronic file formats. They could also join remotely video conferences discussing

social work news issues. On that basis, I find that the following services are also *prima facie* objectionable under section 3(1)(c): *Collection and delivery of messages by electronic mail; Electronic file transfer; Electronic forwarding of messages; Electronic mail and messaging services; Communication services for video conferencing purposes.* Lastly, the mark describes *Chat room services for social networking; Providing access to an Internet discussion website; Providing on-line chat rooms for social networking* which enable users to access and discuss social work news and issues relating to social work news, such as social workers and academics working and studying in that field. The section 3(1)(c) ground succeeds, *prima facie*, in relation to all of the class 38 services.

Class 35: *Advertising analysis; Advertising and advertisement services; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotion services and related consulting; Advertising and promotional services; Advertising and publicity; Advertising and publicity services; Advertising in periodicals, brochures and newspapers; Advertising material (Dissemination of -); Advertising research; Advertising research services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising; Advertising services relating to the recruitment of personnel; Advertising services relating to the sale of goods; Advertising services to promote public awareness of social issues; Advertising space (Rental of -) on the internet; Advertising via electronic media and specifically the internet; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Compilation of advertisements; Compilation of advertisements for use as web pages; Compilation of advertisements for use as web pages on the Internet; Compilation of advertisements for use on the internet; Conducting of trade shows; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising*

purposes; Development of promotional campaigns; Dissemination of advertisements; Event marketing; Exhibitions (Arranging -) for advertising purposes; Exhibitions (Conducting -) for advertising purposes; Job matching services; Magazine advertising; Marketing, advertising, and promotional services; Marketing services provided by means of digital networks; Online advertisements; Online advertising; On-line advertising and marketing services; Pay per click advertising; Preparation and presentation of audio visual displays for advertising purposes; Preparing audiovisual presentations for use in advertising; Product launch services; Product marketing; Providing advertising services; Providing advertising space; Providing advertising space in periodicals, newspapers and magazines; Providing and rental of advertising space on the internet; Providing recruitment information via a global computer network; Provision and rental of advertising space; Provision of advertising space; Provision of space on websites for advertising goods and services; Recruitment advertising; Recruitment of personnel; Retail services in relation to downloadable electronic publications; Texts (Publication of publicity -).

36. The class 35 specification includes *Advertising services to promote public awareness of social issues*. The term 'social issues' includes social work developments and current affairs; i.e. social work news. Social work news is therefore included in the subject matter of the advertising services. A customer procuring these services will see SOCIAL WORK NEWS as a description of the specialism or subject matter of the advertising service, not as a trade mark denoting the services of the applicant and no other undertaking. The mark is objectionable under section 3(1)(c) for *Advertising services to promote public awareness of social issues*. This also means that broader terms covering advertising services in the specification are objectionable under section 3(1)(c) because the broader terms notionally include *Advertising services to promote public awareness of social issues*. There is also an objection for advertising consultancy and research about social work news. On this basis, the following services are descriptive of the subject matter or specialism of social work news:

Advertising analysis; Advertising and advertisement services; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging;

Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotion services and related consulting; Advertising and promotional services; Advertising and publicity; Advertising and publicity services; Advertising in periodicals, brochures and newspapers; Advertising material (Dissemination of -); Advertising research; Advertising research services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services relating to books; Advertising; Advertising via electronic media and specifically the internet; Advertising via the Internet; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advertising, promotional and public relations services; Compilation of advertisements; Compilation of advertisements for use as web pages; Compilation of advertisements for use as web pages on the Internet; Compilation of advertisements for use on the internet; Development of promotional campaigns; Dissemination of advertisements; Event marketing; Exhibitions (Arranging -) for advertising purposes; Exhibitions (Conducting -) for advertising purposes; Magazine advertising; Marketing, advertising, and promotional services; Marketing services provided by means of digital networks; Online advertisements; Online advertising; On-line advertising and marketing services; Pay per click advertising; Preparation and presentation of audio visual displays for advertising purposes; Preparing audiovisual presentations for use in advertising; Providing advertising services; Texts (Publication of publicity -).

37. *Retail services in relation to downloadable electronic publications is objectionable under section 3(1)(c) because the mark describes retailing of publications about social work news. Advertising services relating to the sale of goods is descriptive of advertising relating to the sale of publications (such as those in class 16) about social work news and Product launch services; Product marketing is descriptive of services for marketing and launching publications about social work news.*

38. *Advertising services relating to the recruitment of personnel; Job matching services; Providing recruitment information via a global computer network; Recruitment advertising; Recruitment of personnel.* The mark is descriptive of these services because it describes a characteristic of the recruitment advertising and information. If a social worker was looking for a job, either in a physical recruitment agency branch or the equivalent website and social work job updates were provided in a section of the branch or website under SOCIAL WORK NEWS, that consumer will see those words as a description of the latest social work job information, not as a trade mark. The mark is descriptive of *Conducting of trade shows; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes* if such trade shows and trade fairs have social work news as their subject matter or specialism.

39. *Advertising space (Rental of -) on the internet; Providing advertising space; Providing advertising space in periodicals, newspapers and magazines; Providing and rental of advertising space on the internet; Provision and rental of advertising space; Provision of advertising space; Provision of space on websites for advertising goods and services.* In relation to these services, the mark describes the purpose of the advertising space; for example, space for advertising printed and electronic publications or podcasts about social work news. The mark is objectionable under section 3(1)(c) for these services.

40. In summary, the section 3(1)(c) ground of invalidation succeeds against all the goods and services of the registration.

Section 3(1)(b)

40. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case

C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

41. Paragraph 86 of *Postkantoor* confirms that if a mark is objectionable under section 3(1)(c), it is also objectionable under section 3(1)(b). The section 3(1)(b) ground of opposition succeeds. However, a trade mark may be devoid of distinctive character for the purposes of section 3(1)(b) for reasons other than the fact that it may be descriptive (*Postkantoor*). If I am wrong that all of the services are objectionable under section 3(1)(c) of the Act, I find that they are nevertheless objectionable under section 3(1)(b). In a decision for the Registrar, the Hearing Officer considered the mark COMPUTER BOOKSHOPS in classes 9, 16 and 41.¹² The mark had been objected to by the examiner under sections 3(1)(b) and (c) of the Act on the basis that it described goods and services relating to a shop which sells books about computers. The Hearing Officer waived the objection raised under section 3(1)(c) but maintained that the objection under section 3(1)(b) was validly raised and that the mark was devoid of any distinctive character for the goods and services in the application. He observed that:

“... the Registrar has long been reluctant to register the name of one product as a trade mark for another product in a closely related sector of the market: see Portogram Radio Electrical Company Limited’s Application 69 RPC [1952] 241 at 245. I believe that it is self evident why the word “duvet”, for example, would not be able to function as a trade mark for bed sheets, or why the word “shirt” would not function as a trade mark for ties. In use in relation to such goods these signs would be, at best, ambiguous as to their meaning, and would probably just result in confusion. A similar point arose in a recent decision dated 2 May 2002 of Mr G Hobbs QC as Appointed Person in Fourneaux de France Limited v The Range Cooker Co. plc, SRIS 0-240-02.”

42. In BL O/218/02, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered the mark “Tools and Middleware” to be devoid of any distinctive character for a wide range of goods in class 9. The applicant had tried to overcome the examiner’s descriptiveness objection to the mark by limiting the specification

¹² BL O/266/02.

away from tools and middleware; tools describing a type of software, and middleware describing computer products which sit between hardware and software. Mr Hobbs considered that the mark was “an ordinary way of designating the general nature of the goods of interest to the Applicant and are not likely to trigger origin-specific perceptions and recollections in the mind of the average consumer of the goods concerned.”

43. The public interest underlying section 3(1)(b) of the Act is described in *BORCO*: the mark “must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings”. In my view, if SOCIAL WORK NEWS is not directly descriptive of services relating to social work news, SOCIAL WORK NEWS is still ambiguous because there is insufficient clear blue water between goods and services for which the description is apt and services which are closely allied to the goods and services for which the description is apt. The mark will not trigger in the mind of the average consumer, particularly social workers, a trade-origin specific message. The words will be perceived as origin neutral. For this reason, the mark would not be able to do the job of identifying the commercial source of the services and would not, therefore, perform the essential function of a trade mark which is to distinguish the registered proprietor’s services from those of other traders.

44. The invalidation succeeds against all the goods and services under section 3(1)(b) of the Act.

Acquired distinctiveness

45. I have found the contested mark to be *prima facie* objectionable under sections 3(1)(b) and (c). The proprietor has filed evidence which is mostly about what the applicant has done, but there is a small amount referring to the proprietor’s own mark. The proviso to section 47(1) of the Act states:

“Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section [section 3], it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

46. The relevant date for the present assessment is the date on which the application for invalidation was filed: 9 June 2023. The CJEU provided guidance in *Windsurfing Chiemsee* as to the correct approach with regard to the assessment of the acquisition of distinctive character through use.¹³ The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

47. The registered proprietor's evidence about its own use of its mark is very thin. It includes the hearsay evidence of Ms Stark. Even if I were to place weight upon her statement, the facts within it that relate to the proprietor's use of SOCIAL WORK NEWS are underwhelming. Buying a domain name in 2006 does not equate to use of the trade mark. The mere existence of the registered domain name is not use of

¹³ Joined cases C-108 & C-109/97.

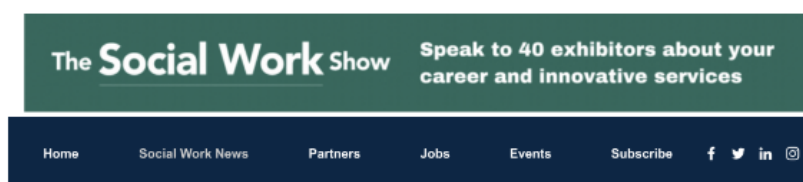
the trade mark; intention to use is not the same as actual use. It appears that the mark was not used until 2015, according to Ms Stark. However, there is no evidence about use in 2015, 2016, 2017, 2018 or 2019. Ms Doubtfire states that the website was launched in October 2020. However, the timeline she gives in her evidence shows that the launch in October 2020 was in respect of Social Work Today, which she describes as “a social work news online publication with a social work news section.” This is not trade mark use of the words SOCIAL WORK NEWS: it is descriptive use.

48. Ms Doubtfire states that the registered proprietor has been using the mark continuously, but it is the Social Work Today emails which are sent to a circulation list at 10am every day. There is no information about how many people or entities receive the email. A specific section in the emailed newsletter, Social Work Today, is called Social Work News. This is not the title of the newsletter and will be seen as a descriptive title of a section within the newsletter called Social Work Today which is about social work news; just as the other sections are “Social Work Jobs” and Social Work Events”, which are also descriptive section titles. No newsletters have been provided in the evidence and there are no screenshots to show the Social Work News section on the Social Work Today website. All the examples of promotional material are undated. None of the evidence comes anywhere near to establishing that the contested mark has acquired distinctiveness through use.

49. I referred earlier in this decision to inadmissible evidence filed as written submissions in lieu of a hearing. I have looked at this in order to confirm for the benefit of the registered proprietor that the factual content is inadequate and would not have assisted the registered proprietor. The statement of Ms Stark is replicated and I have already discussed the content of that (and that it is hearsay). Mr Pearson says in his inadmissible witness statement that the registered proprietor’s plans to use the mark have been hampered by spending time and money on legal cases brought by the applicant. He repeats his conclusions about the applicant’s activities with regard to SOCIAL WORK NEWS, which is irrelevant. Mr Pearson refers to his company’s track record in producing publications under other brand names, which is irrelevant. He says that nobody else had registered the mark and there was no information about the mark being a specific publication, so the registered proprietor

applied for the mark. The reason why nobody had registered it as a trade mark is because it is objectionable under sections 3(1)(b) and (c). Similarly, although other organisations use the words, the fact that there is no single publication with SOCIAL WORK NEWS as its front page title underlines the fact that it is devoid of any distinctive character; entities are unlikely to choose words as a brand name which cannot do the job of distinguishing their publication from those of other undertakings.

50. Ms Doubtfire says in her inadmissible witness statement that the registered proprietor has been using the contested mark “within the Social Work Today brand with a view to future development as its own product.” This does not support a finding that the contested mark has stood on its own as an indicator of trade origin. Further, listing plans as to how the mark will be used is not use of the trade mark that has already taken place. The exhibits are from the current website and do not show the mark without a logo; or they show the mark as a subheading which looks descriptive:



51. The inadmissible witness statement of John McGowan, the General Secretary of the Social Workers Union, has no facts about the use of the mark by the proprietor (it criticises the applicant). The inadmissible witness statement of Steve Stuart, who is technical lead for the West Midland Association for Directors of Children's Services, gives facts about the registered proprietor but little about its use of the contested mark. He describes it in a generic way:

“In this respect they [Compass Comms] have continued to bring quality content to the sector and provide trusted Social Work News that is now part of their branding...”.

52. Although Mr Stuart also says he works with a number of government and voluntary sector organisations “who regularly receive their Social Work News from Compass Comms”, without any figures or more specific detail, this statement would not have assisted the registered proprietor since its admissible evidence is so lacking in detail. Mr Stuart's statement cannot corroborate something that is missing in the first place.

Overall outcome

53. The invalidation succeeds in full under sections 3(1)(b) and (c) of the Act. Under section 47(6) of the Act, the registration is deemed never to have been made.

Costs

54. The applicant has been successful and is entitled to a contribution to its costs on the basis of the scale published in Tribunal Practice Notice 1/2023. The Appointed Person has already awarded costs against the registered proprietor for the appeal against the procedural decision, so I do not need to take the appeal into account in my calculations. It would be appropriate to add £300 in favour of the applicant for its success at the interlocutory hearing which led to the appeal, the costs of that hearing being reserved until now. However, this is cancelled out by the fact that the applicant objected to the Tribunal's preliminary view that the registered proprietor be granted leave to appeal. The objection resulted in a CMC (held on 6 October 2023),

at which the Hearing Officer decided that the registered proprietor was granted leave to appeal, which means that the applicant was unsuccessful at the CMC. I have included an amount, £200, in favour of the applicant for its attendance at the CMC regarding the registered proprietor's submissions in lieu of a hearing; these were objected to by the Tribunal, but the applicant attended the CMC and made brief submissions against admitting the documents. I have reduced the evidence award to take account of the fact that the applicant's evidence contained next to no facts; this amount is in respect of considering the registered proprietor's evidence. The breakdown of the award is as follows:

Fee for TM26(I)	£200
Filing the application and considering the counterstatement	£400
Considering and commenting on the other side's evidence	£500
CMC re registered proprietor's submissions in lieu of a hearing	£200
Submissions in lieu of a hearing	£350
Total	£1650

55. I order Compass Comms Limited to pay to Sanctuary Personnel Limited the sum of **£1650**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of May 2025

**Judi Pike
For the Registrar,
the Comptroller-General**